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EXAMINER

GWARTNEY, ELIZABETH A

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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DETAILED ACTION

1. The Amendment filed 04/1/09 has been entered. Claims 1-6 and 8-20 have been amended and claim 7 has been cancelled. Claims 1-6 and 8-20 are pending.
2. The previous claim objections and 112 2nd Paragraph rejections have been withdrawn in light of applicant's amendments made 04/21/2009.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation "the coated fat-based confectionery" in line 2. There is insufficient antecedent basis for this limitation in the claim. While there is sufficient antecedent basis for the recitation "the fat-based confectionery" there is not for "the *coated* fat-based confectionery."

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-4, 6-8 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woznicki et al. (US 4,802,924).

Regarding claims 1-4, 6-7 and 18-19, Woznicki et al. disclose a film coated chocolate product wherein the film coating comprises a cellulosic polymer, polydextrose, a plasticizer, and lecithin (C2/L32-68).

While Woznicki et al. disclose a film coated chocolate product, the reference does not explicitly disclose that thickness of the film coating is 1 micrometer to 1 millimeter or that the film coating is 0.01% to 10%, 0.5 to 6%, or 2 to 5% by weight of the fat-based confectionery

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product. As coating smoothness and shininess are variables that can be modified, among others, by adjusting the film thickness and the amount of film coating, the precise film thickness and amount of film coating on the fat-based confectionery product would have been considered result effective variables by one of ordinary skill in the art at the time of the invention. As such, without showing unexpected results, the claimed film thickness and amount of film coating cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine experimentation, the film thickness and amount of film coating on the chocolate product of Woznicki et al. to obtain the desired coating shininess and smoothness (*In re Boesch*, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (*In re Aller*, 105 USPQ 223).

Given Woznicki et al. disclose a film coated chocolate product identical to that presently claimed, it is clear that it would intrinsically be heat shape stable and heat resistant.

Regarding claim 8, Woznicki et al. disclose all of the claim limitations as set forth above and that the product is a chocolate product coated with a film comprising lecithin (C2/L49,64-68).

Woznicki et al. does not explicitly disclose that the chocolate product is less than 15 millimeters in width. It would have been obvious to one of ordinary skill in the art at the time of the invention to vary the thickness of the chocolate product since such a modification would have involved a mere change in the size. Change in size is not patently distinct over the prior art absent persuasive evidence that the particular configuration of the claim invention is significant.

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See *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). MPEP 2144.04[R-1].

Regarding claim 16, Woznicki et al. disclose all of the claim limitations as set forth above and that the film forming coating agent is polydextrose and a cellulosic polymer selected from the group consisting of hydroxypropyl methylcellulose or hydroxypropyl cellulose (C2/L32-40).

Regarding claim 17, Woznicki et al. disclose all of the claim limitations as set forth above and that the plasticizer is chosen from the group consisting of polyethylene glycol and propylene glycol (C2/L41-42).

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woznicki et al. (US 4,802,924) in view of Steffenino et al. (US 6,274,162).

Regarding claim 5, Woznicki et al. disclose all of the claim limitations as set forth above and that the film coating comprises colorant (C2/L43-48). However, Woznicki et al. does not disclose that the film coating comprises flavorant.

Steffenino et al. teach a film coated confectionery product wherein the film coating comprises hydroxyethyl cellulose, a plasticizer, a colorant and a flavorant (Abstract). Steffenino et al. teach that flavorant is used primarily for taste and/or odor masking (C3/L38-39).

Woznicki et al. and Steffenino et al. are combinable because they are concerned with the same field of endeavor, namely, film-coated confectionery products. It would have been obvious to one of ordinary skill in the art at the time of the invention to have added flavorant, as taught

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by Steffenino et al., to the film coating of Woznicki et al. for the purpose of adding flavor and masking off-flavors.

10. Claims 9-10, 13, 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooking Light (“Chewy Chocolate-Chip Cookies”) in view of Woznicki et al. (US 4,802,924).

Regarding claims 9-10, 13, 15 and 20, Cooking Light discloses chocolate chip cookies comprising chocolate chips (i.e. fat-based confectionery product) and flour (p.1/Title, Ingredients). Cooking Light also discloses a method to produce the cookies by using chocolate chips (p.1/entire recipe). Cooking Light does not disclose that the confectionery product is heat shape stable, heat resistant or comprises a film coating having a thickness from 1 micrometer to 1 millimeter.

Woznicki et al. teach a chocolate film coated with polydextrose, cellulosic polymer, plasticizer, lecithin, and colorant (Abstract, C2/L33-68).

While Woznicki et al. teach a film coated chocolate product, the reference does not explicitly disclose that thickness of the film coating is 1 micrometer to 1 millimeter. As coating smoothness and shininess are variables that can be modified, among others, by adjusting the film thickness, the precise film thickness would have been considered a result effective variable by one of ordinary skill in the art at the time of the invention. As such, without showing unexpected results, the claimed film thickness cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine experimentation, the film thickness on the chocolate product of Woznicki et al. to obtain the

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desired coating shininess and smoothness (*In re Boesch*, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (*In re Aller*, 105 USPQ 223).

Given that Woznicki et al. teach a film coated chocolate identical to that presently claimed, it is clear that it would intrinsically be heat shape stable and heat resistant.

Cooking Light and Woznicki et al. are combinable because they are concerned with the same field of endeavor, namely, confectionery products. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the film-coated chocolate, as taught by Woznicki et al. in the chocolate chip cookies of Cooking Light because doing so would amount to nothing more than the use of a known chocolate confectionery for its use in a known environment to accomplish entirely expected results. Further, by doing so the shape of the chocolate would remain intact and more colorful cookies would be produced.

Given that Woznicki et al. disclose a film coated chocolate identical to that presently claimed, it is clear that intrinsically the color from the coating would not bleed into or onto the food product.

11. Claims 10-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bon Appétit (“Black Forest Fudge”) in view of Woznicki et al. (US 4,802,924).

Regarding claims 10-11, Bon Appétit discloses fudge comprising chocolate chips sprinkled on top (i.e. fat-based confectionery product). Bon Appétit does not disclose that the confectionery product is heat shape stable, heat resistant or comprises a film coating.

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Woznicki et al. teach a chocolate film coated with polydextrose, cellulosic polymer, plasticizer, lecithin, and colorant (Abstract, C2/L33-68). Given that Woznicki et al. teach a film coated chocolate identical to that presently claimed, it is clear that it would intrinsically be heat shape stable and heat resistant.

Bon Appétit and Woznicki et al. are combinable because they are concerned with the same field of endeavor, namely, confectionery products. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the film-coated chocolate, as taught by Woznicki et al. sprinkled on top of the fudge of Bon Appétit because doing so would amount to nothing more than the use of a known chocolate confectionery for its use in a known environment to accomplish entirely expected results. Further, by doing so the shape of the chocolate would remain intact and more colorful fudge would be produced.

Regarding claim 12, modified Bon Appétit discloses all of the claim limitations as set forth above but the reference does not explicitly disclose that the food product has a uniform texture. Given that Bon Appétit discloses stirring the mixture vigorously (p.1/Preparation, paragraph 2) it necessarily follows that the fudge would have a uniform texture.

Regarding claim 14, modified Bon Appétit discloses all of the claim limitations as set forth above. Woznicki et al. disclose that the film coating comprises lecithin (C2/L49). However, there is no disclosure that the chocolate pieces are less than 15 millimeters in width. It would have been obvious to one of ordinary skill in the art at the time of the invention to vary the thickness of the chocolate product since such a modification would have involved a mere change in the size. Change in size is not patently distinct over the prior art absent persuasive evidence that the particular configuration of the claim invention is significant. See *In re Rose*, 220 F.2d

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459, 105 USPQ 237 (CCPA 1955); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). MPEP 2144.04[R-1].

Response to Arguments

12. Applicant's arguments filed 04/21/2009 have been fully considered but they are not persuasive.

Applicants argue that Woznicki et al. fail to disclose or suggest a film coating having a thickness from 1 micrometer to 1 millimeter. Further, applicants argue that the amount of film coating on the fat-based confectionery product and film thickness would **not** have been considered a result effective variable. Applicants submit that the thickness of the film coating would be understood as providing heat stability and heat resistance to the confectionery product underlying the film coating.

It is agreed that Woznicki et al. fail to explicitly disclose a film coating having a thickness from 1 micrometer to 1 millimeter or the recited amount of film coating. However, because factors such as coating smoothness, shininess and hardness are variables that can be modified by adjusting the amount of film coating and thickness film coating on a confectionery product, absent evidence to the contrary, the precise amount film coating and film coating thickness would have been considered result effective variables by one of ordinary skill in the art at the time of the invention.

Because there is substantial evidence to support determination of a prima facie case of obviousness over each of the applied prior art references, the burden of proof was properly shifted to the applicants to rebut the prima facie case by presenting persuasive arguments or

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evidence (e.g. unexpected results). *In re Mayne*, 104 F.3d 1339, 1343, 41 USPQ2d 1451, 1455 (Fed. Cir. 1997). ("With a factual foundation for its prima facie case of obviousness shown, the burden shifts to applicants to demonstrate that their claimed fusion proteins possess an unexpected property over the prior art."). Applicants have not met their burden. While applicants find that that film coating thickness and the amount of film coating are not result effective variables, applicants have not provided any evidence to the contrary (i.e. unexpected results). While film coating thickness may provide heat stability and heat resistance to the confectionery, other variables such as smoothness, shininess and hardness also change as a function of film coating thickness and amount.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Gwartney whose telephone number is (571) 270-3874. The examiner can normally be reached on Monday - Friday; 7:30AM - 3:30PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. G./

Examiner, Art Unit 1794

/KEITH D. HENDRICKS/

Supervisory Patent Examiner, Art Unit 1794